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EXAMINER

RHEE, JANE J

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/743,710
Filing Date: January 16, 2001
Appellant(s): POULAKIS ET AL.

Mark S. Bicks, Esquire Roylance, Abrams, Berdo & Goodman, L.L.P.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/19/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because applicant introduces new matter that was not supported by the original specification. The new matter issue pertains to the ferromagnetic covering that extends throughout the entire foam-inhibiting covering.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter in the claims 9 and 19 is “a ferromagnetic coating extending through out the entire length and width of the foam inhibiting covering.”

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5,442,156	Billarrant	6-1995
WO 8,603,164	Provost	6-1986

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: 9-19

The 35 U.S.C. 112 1st paragraph rejection and the objection to the Specification of claim 19 has been withdrawn due to applicant's argument. Claims 9-18 introduces new matter.

The 35 U.S.C. 103(a) rejection of claim 19 has been withdrawn due to applicant's argument that Billarrant fails to disclose that the covering has a felt or fleece lamina thereon.

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9-18 rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 3/27/2003.

Specification

1. The amendment filed 1/15/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The new matter in the specification is “the subject matter of which is hereby incorporated by reference” and the new matter in the claim 9 is “a ferromagnetic coating extending through out the entire length and width of the foam inhibiting covering.”

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 9-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter in the claims 9 and 19 is “a ferromagnetic coating extending through out the entire length and width of the foam inhibiting covering.”

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Billarant (5442156) in view of Provost (WO 86/03164).

Billarant discloses a method for producing a foam body part having at least one adhesive closing part with adhering elements (figure 6 number 18 and 15), comprising the steps of arranging an adhesive closing part in a foam mold (figure 6 number 51) for forming a foamed body part, the adhesive closing part having first (figure 6 number 15) and second (figure 6 number 18) opposite surfaces and having adhering elements extending from the first surface (figure 6 number 15); protecting the adhering elements on the adhesive closing part against penetration of foam by arranging a foam-inhibiting covering (figure 6 number 20) on the second surface (figure 6 number 18) of adhesive closing part to be remote from the adhering elements, the foam-inhibiting covering having a predetermined peripheral border width overlapping and extending beyond a surface area of the adhering elements (figure 6 number 20); and bringing the foam-inhibiting covering into detachable contact with parts of the foaming mold by permanent magnets in parts of the foaming mold (figure 6 number 52 and col. 6 line 18) attracting a ferromagnetic coating (figure 6 number 23), the permanent magnets being placed laterally about a periphery of a portion of the foaming mold (figure 6 number 52) receiving the adhering elements of the adhesive closing part to cooperate with the peripheral border of the covering overlapping the surface area of the adhering elements (figure 6 numbers 52 and 24). Billarant

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discloses an adhesive layer connects the covering element to the adhesive closing part (col. 5 lines 37-40). Billarant discloses that the adhering elements are received in a recess in the foaming mold (figure 6 number 18 and 50); and the border of the foam-inhibiting covering overlaps the recess (figure 6 number 53). Billarant discloses that the foam-inhibiting covering has a synthetic layer and a layer containing ferromagnetic substances and forms an adhesive base of the adhesive closing part (col. 5 lines 37-39). Billarant fail to disclose that the ferromagnetic coating extending throughout the entire foam-inhibiting coating. Billarant fail to disclose that the ferromagnetic coating is polyurethane with added iron particles. Billarant fail to disclose that the synthetic resin layer is a polyurethane layer. Provost teaches that polyurethane is a notoriously well-known adhesive in the art (pg 3 lines 20-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Billarant with polyurethane in the ferromagnetic coating and as the synthetic layer in order to better adhere the covering element to the adhesive closing part as taught by Provost.

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided ferromagnetic coating extending throughout the entire foam-inhibiting coating in order to better secure the covering element to the adhesive closing part.

(10) *Response to Argument*

Applicant argues that the new limitation "ferromagnetic coating extending throughout the entire foam-inhibiting covering" did not introduced new matter to the specification and contends that the new limitation was incorporated by polyurethane SU-9182 of Firma Stahl (i.e.,Stahl

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Holland B.V.) reference in the original specification. Applicant further provided examples from the original specification wherein the support for the new matter was derived from, as shown below;

“The covering can be provided with a ferromagnetic coating of polyurethane, as is commercially available under the name SU-9182 from Firma Stahl and contains mixed-in Fe particles of granular size $>10\mu$ as ferromagnetic material”. (page 3, lines 6-9 of modified sheets)

“For this purpose it is possible to proceed so that the covering element is provided with a ferromagnetic coating, for example with a coating of the polyurethane, as is commercially available under the name SU-9182 by Firma Stahl, which contains admixed Fe particles of granular size $<10\mu$ as ferromagnetic material”. (page 3 lines 12-15, of original sheets)

“The tight connection of adhering elements 5 with covering element 15, in deviation from the diagrammatic representation of fig 3A, can also occur directly through a polyurethane coating containing ferromagnetic substances, which can be for example the polyurethane SU-9182 of Firma Stahl.” (page 5, lines 21-24 of original sheets)

“6. Method as in claim 5, characterized in the polyurethane SU-9182 (Firma Stahl) is used as ferromagnetic coating with the addition of Fe particles.” (original sheets)

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“2. Method as in claim 1, characterized in that polyurethane SU-9182 (Firma Stahl) is used as ferromagnetic coating with the addition of Fe particles.” (original sheets)

In response to this argument, MPEP 608.01(p), section 1 paragraph 2 states “An application for a patent when filed may incorporate “essential material” by reference to (1) a U.S. Patent, (2) A U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below. “essential material” is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent applications, (3) a U.S. patent or application which itself incorporates “essential material” by reference, or (4) a foreign application.” Furthermore, in paragraph 4 of MPEP 608.01(p) states “mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). MPEP 608.01(p) clearly states that essential materials may not be incorporated by reference to non patent applications and that merely referencing to another publication is not an incorporation of anything therein into the application containing such reference for the purpose of disclosure required by 35 U.S.C. 112 first paragraph, therefore, the new limitation “ferromagnetic coating extending throughout the entire foam-inhibiting covering” is not supported by the original specification.

Applicant argues that Billarant's protective film 20 is on the first surface of the adhesive closing part, i.e., that surface from which the closing elements 18 extend, thus, the Billarant's protective film 20 is adjacent and not remote from the adhering elements as recited in claims 9 and 19, and also, the protective film does not cover or protect elements 15 from the foam since they are imbedded in the foam.

In response to this argument, claim 9 and 19 states in the second paragraph, "protecting the adhering elements on the adhesive closing part closing part against penetration of foam by arranging a foam inhibiting covering on the second surface of the adhesive closing part to be remote from the adhering elements, the form inhibiting covering having a predetermined peripheral border width overlapping and extending beyond a surface area of the adhering elements;" applicant first contends that the protective film is on the first surface of the adhesive closing part, i.e., that surface from which the closing elements 18 extend, however in the previous office action, it is clearly stated that the first surface of the adhesive closing part having elements extend from are referred to elements 15 and not 18 as shown below;

Billarant discloses a method for producing a foam body part having at least one adhesive closing part with adhering elements (figure 6 number 18 and 15), comprising the steps of arranging an adhesive closing part in a foam mold (figure 6 number 51) for forming a foamed body part, the adhesive closing part having first (figure 6 number 15) and second (figure 6 number 18) opposite surfaces and having adhering elements extending from the first surface (figure 6 number 15); protecting the adhering elements on the adhesive closing part against penetration of foam by arranging a foam-inhibiting covering (figure 6 number 20) on the second surface (figure 6 number 18) of adhesive closing part to be remote from the adhering elements, the foam-inhibiting covering having a predetermined peripheral border width overlapping and extending beyond a surface area of the adhering elements (figure 6 number 20).

therefore, the protective film is remote from adhering elements 15 and protects adhering elements 18 against penetration of the foam. Applicant claims in claim 9 and 19, second

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paragraph, “protecting the adhering elements on the adhesive closing part closing part against penetration of foam by arranging a foam inhibiting covering on the second surface of the adhesive closing part to be remote from the adhering elements, the form inhibiting covering having a predetermined peripheral border width overlapping and extending beyond a surface area of the adhering elements;” however did not claim that both the first and second opposite surfaces having adhering elements are protected by the foam inhibiting cover and wherein both adhering elements are remote from the foam inhibiting covering. Therefore, Billarant discloses protecting the adhering elements on the adhesive closing part against penetration of foam by arranging a foam-inhibiting covering (figure 6 number 20) on the second surface (figure 6 number 18) of adhesive closing part to be remote from the adhering elements, the foam-inhibiting covering having a predetermined peripheral border width overlapping and extending beyond a surface area of the adhering elements (figure 6 number 20).

Applicant argues that the Billarant magnet 52 is located within the mold recess receiving the adhesive closing part, and is not laterally about the periphery of that portion of the mold as recited in claims 9 and 19.

In response to this argument, figure 6 clearly shows that the magnet 52 is located laterally about a periphery of the portion of the mold as recited in claims 9 and 19. Claims 9 and 19 states in paragraph 3 lines 3-6 “the permanent magnets being placed laterally about a periphery of a portion of the foaming mold receiving the adhering elements of the adhesive closing part to cooperate with the peripheral border of the covering overlapping the surface area of the adhering elements.” However, claims 9 and 19 did not state that the magnet is laterally about *the* periphery of that portion of the mold, but “a periphery of a portion of the foaming mold” which merely

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states that magnet need only to be on a periphery of a portion of the foaming mold instead of the periphery of that portion of the mold. The differences being that *the* periphery of that portion of the mold would comprise magnets around the periphery of the mold wherein *a* periphery of a portion of the foaming mold would pertain to any part of the periphery of a portion of the foaming mold instead of around the periphery of the mold.

Applicant argues that Billarant patent fails to teach or suggest to one of ordinary skill in the art to provide ferromagnetic coating throughout the entire foam inhibiting covering, since the ferromagnetic coating only extends across a portion of the width of covering 20 corresponding to magnet 52, as clearly illustrated in Figure 6.

In response to this argument, the limitation “ferromagnetic coating extending throughout the entire foam-inhibiting covering” introduces new matter to the original specification as described above therefore applicant’s argument is moot concerning this limitation. However, this limitation was rejected as being obvious to one of ordinary skill in the art at the time applicant’s invention was made to have provided ferromagnetic coating extending throughout the entire foam-inhibiting coating in order to better secure the covering element to the adhesive closing part.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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